



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,104	08/22/2001	Natalie Bryant	3245/FBR	9322

26304 7590 06/05/2003

KATTEN MUCHIN ZAVIS ROSENMAN  
575 MADISON AVENUE  
NEW YORK, NY 10022-2585

EXAMINER

JONES, SCOTT E

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/935,104

Applicant(s)

BRYANT, NATALIE

Examiner

Scott E. Jones

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because it exceeds 150 words as required by 37 C.F.R. § 1.72(b). Correction is required. See MPEP § 608.01(b).

### *Claim Objections*

2. Claim 1 is objected to because of the following informalities: Claim 1, as drafted, does not adhere to standard U.S. claim practice as described in 37 C.F.R. 1.75. Correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Jaffe et al. (U.S. 6,358,147).

Jaffe et al. discloses a gaming machine with multiple payoff modes, the second payoff mode defining a “Super Scatter” feature. In the Super Scatter mode, winning outcomes are identified by the predetermined winning symbol combinations appearing in the symbol group in scatter-pay format. In scatter-pay format, winning combinations occur when predefined winning symbol combinations are displayed in any position, on any of the reels. Thus, symbols making up winning combinations in the Super Scatter mode do not need to be aligned with an active payline or displayed on particular reels. Jaffe et al. discloses:

Regarding Claim 1:

- one of the symbols of the set of symbols on the reels of a gaming machine is a scatter symbol (Column 1, line 45-Column 2, line 37, and Column 8, line 40-Column 13, line 67). All symbols are scatter symbols in Super Scatter mode.
- in respect to at least one of the reels, the set comprising more than one occurrence of the scatter symbol (Table 1). All symbols are scatter symbols in Super Scatter mode.
- when more than a minimum number of scatter symbols are displayed at any one time, all the displayed scatter symbols contributing to a single paying combination of the scatter symbols (Figure 5).

Furthermore, the claim limitation, “the scatter symbols on said at least one reel being arranged on the reel so that more than one scatter symbol is able to be displayed simultaneously when the reels are in a rest condition” is not positively recited and only provides for a “possibility” that this may occur.

Regarding Claim 2:

- the display means is a video display unit and the display of the reels is constituted by a video simulation (Column 3, lines 13-30, and Figures 1-5).

Regarding Claim 3:

- the set of symbols on each of the reels has more than one occurrence of the scatter symbol (Table 1).

Regarding Claim 4;

- the set of symbols of each reel has at least two scatter symbols (Table 1).

Regarding Claim 5:

- the scatter symbols are positioned on each reel such that up to three scatter symbols are able to be displayed at any one time (Figure 5 and Column 8, lines 40-67).

*Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DeMar et al. '855, Jaffe'187, Slomiany et al. '098, Jaffe et al. '837, Yoseloff et al. '208, Anderson et al. '766, and Bennett '254 disclose gaming machine systems and methods employing scatter game features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE can be reached on (703) 308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ  
sej  
May 29, 2003



John Hatling